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ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)			KIM, CHONG R	
136 S WISCONSIN ST				
PORT WASHINGTON, WI 53074			ART UNIT	PAPER NUMBER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SCOTT E. TREVINO, RANJEETA SINGH,  
VEENA HALLEPPANAVAR, ROBERT H. HAWORTH  
and GRAEME MCKINNON

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Appeal 2007-002903  
Application 09/683,130  
Technology Center 2600

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Decided: May 5, 2010

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Before KENNETH W. HAIRSTON, MAHSHID D. SAADAT

and ROBERT E. NAPPI, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

In a Decision dated January 8, 2008, the Board affirmed the Examiner's anticipation rejection of claims 9 to 18, and affirmed the Examiner's obviousness rejections of claims 1 to 8 and 19 to 31. Appellants

have requested a rehearing of our decision to affirm the Examiner's anticipation rejection of claims 9 and 12 (Req. Reh.g 2 to 7).

Appellants argue (Req. Reh.g 7) that "**Prosecution Must be Reopened Because When the Board Agreed with Appellant on its Argument Regarding Claim 9, it Erred in Stating that Appellant Had Not Shown that the Examiner Erred.**" As stated by the Board (Dec. 8), "[t]he first issue before us is whether the Examiner erred in rejecting claim 9 under 35 U.S.C. § 102(e)" (Dec. 4). Although we disagreed with a statement made by the Examiner about a referenced section of Wu (Dec. 8), we demonstrated that the Examiner had not erred in rejecting this claim under 35 U.S.C. § 102(e) because

Wu teaches that the operator hierarchically prioritizes the scan parameters in: parameters which are fixed such as the FOV, modifiable parameters such as those displayed in Figure 2A which include resolution 104, and monitor parameters such as those shown in Figure 2B including imaging time 206 (Finding of Fact 2). This hierarchy of the scan parameters is the same as the one disclosed in the current disclosure which includes the respective: primary parameters including FOV, secondary parameters including resolution and tertiary parameters including timing (Spec. ¶ [0166]).

Thus, we are not persuaded by the Appellants' argument because Wu expressly discloses hierarchically prioritizing the plurality of scan parameters for the scan session under the broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art.

(Dec. 8).

The Board did not make a new ground of rejection merely because we demonstrated through other teachings in Wu<sup>1</sup> that the Examiner had not erred in rejecting this claim for anticipation based on Wu (Req. Reh.g 2 and 7).

Since the teachings of Wu mirror the teachings of the disclosed and claimed invention, we still maintain that the scan session in Wu will operate in the same manner as set forth in claim 9 on appeal to hierarchically prioritize scan parameters during a scan session (Dec. 8; Req. Reh.g 3 and 4)

Appellants argue (Req. Reh.g 4) that “**The Board Erred in Not Considering Claim 12 in its Entirety.**” Appellants’ arguments (App. Br. 6 and 7) were simply that Wu fails to teach that a user can directly change a tertiary scan parameter and that Wu is not allowed to affect another of the set of tertiary parameters. No other limitation in claim 12 was discussed in connection with the teachings of Wu. The mere recital of the other limitations of claim 12 (i.e., the primary scan parameters and the secondary scan parameters) (App. Br. 6 and 7) without arguments as to how those limitations are not found in Wu is not convincing of the patentability of claim 12. In summary, the Board did not err because arguments (Req. Reh.g 5 and 6) which Appellants could have made but did not make in the Briefs have not been considered and are deemed to be waived.

Appellants’ request for rehearing has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

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<sup>1</sup> In an anticipation rejection, Appellants are charged with knowledge of all of the teachings of Wu.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

**REHEARING DENIED**

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